

APR 12 2006

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TO: Mail Stop Appeal Brief - United States Patent and Trademark Office

Fax No. 571-273-8300 Phone No.

FROM: Cora A. Wray (Typed or printed name of person signing Certificate)

Fax No. 513-626-1355 Phone No. 513-626-6622

Application No.: 09/902,048

Inventor(s): Michael Lee Vatter

Filed: July 10, 2001

Docket No.: 8163

Confirmation No.: 7755

FACSIMILE TRANSMITTAL SHEET AND
CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on April 12, 2006, to the above-identified facsimile number.

Cora A. Wray (Signature)

Listed below are the item(s) being submitted with this Certificate of Transmission:**

- 1) Fee Transmittal – 1 page
- 2) Appeal Brief – 8 pages

Number of Pages Including this Page: 10**Comments:**

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8163 (FAX-USPTO.doc Revised 11/18/2005)

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BC IP DIVISION

APR 12 2006

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PTO/SB/17 (1-06)
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL for FY 2006 Patent fees are subject to annual revision. Effective December 8, 2004		Complete if Known	
		Application Number	09/902,048
		Confirmation Number	7755
		Filing Date	July 10, 2001
		First Named Inventor	Michael Lee Vatter
		Examiner Name	Shengjun Wang
		Art Unit	1617
TOTAL AMOUNT OF PAYMENT (\$500)		Attorney Docket No. 8163	

METHOD OF PAYMENT			FEES CALCULATION (continued)																															
<p>1. [X] The Director is hereby authorized to charge indicated fees submitted on this form, credit any over payments, and charge any additional fee(s) during the pendency of this application to:</p> <p>Deposit Account Number: 16-2480 Deposit Account Name: The Procter & Gamble Company</p>			<p>5. ADDITIONAL FEES</p> <table> <thead> <tr> <th><u>Fee Description</u></th> <th><u>Fee Paid</u></th> </tr> </thead> <tbody> <tr> <td>Extension for reply within 1st month</td> <td>(\$120) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 2nd month</td> <td>(\$450) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 3rd month</td> <td>(\$1,020) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 4th month</td> <td>(\$1,590) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 5th month</td> <td>(\$2,160) <input type="checkbox"/></td> </tr> <tr> <td>Information Disclosure Statement fee</td> <td>(\$180) <input type="checkbox"/></td> </tr> <tr> <td>37 CFR 1.16(f) Late Oath/Declaration (nonprovisional)</td> <td>(\$130) <input type="checkbox"/></td> </tr> <tr> <td>37 CFR 1.17 (q) Surcharge - Late provisional filing fee or cover sheet</td> <td>(\$50) <input type="checkbox"/></td> </tr> <tr> <td>Non-English specification</td> <td>(\$130) <input type="checkbox"/></td> </tr> <tr> <td>Notice of Appeal</td> <td>(\$500) <input type="checkbox"/></td> </tr> <tr> <td>Filing a brief in support of an appeal</td> <td>(\$500) <input checked="" type="checkbox"/></td> </tr> <tr> <td>Request for oral hearing</td> <td>(\$1,000) <input type="checkbox"/></td> </tr> <tr> <td>Acceptance of unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (a) or (c)</td> <td>(\$1,370) <input type="checkbox"/></td> </tr> <tr> <td>Other:</td> <td><input type="checkbox"/></td> </tr> </tbody> </table>		<u>Fee Description</u>	<u>Fee Paid</u>	Extension for reply within 1 st month	(\$120) <input type="checkbox"/>	Extension for reply within 2 nd month	(\$450) <input type="checkbox"/>	Extension for reply within 3 rd month	(\$1,020) <input type="checkbox"/>	Extension for reply within 4 th month	(\$1,590) <input type="checkbox"/>	Extension for reply within 5 th month	(\$2,160) <input type="checkbox"/>	Information Disclosure Statement fee	(\$180) <input type="checkbox"/>	37 CFR 1.16(f) Late Oath/Declaration (nonprovisional)	(\$130) <input type="checkbox"/>	37 CFR 1.17 (q) Surcharge - Late provisional filing fee or cover sheet	(\$50) <input type="checkbox"/>	Non-English specification	(\$130) <input type="checkbox"/>	Notice of Appeal	(\$500) <input type="checkbox"/>	Filing a brief in support of an appeal	(\$500) <input checked="" type="checkbox"/>	Request for oral hearing	(\$1,000) <input type="checkbox"/>	Acceptance of unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (a) or (c)	(\$1,370) <input type="checkbox"/>	Other:	<input type="checkbox"/>
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<p>2. <u>BASIC FILING FEE - Large Entity</u></p> <table> <thead> <tr> <th><u>FILING FEE</u></th> <th><u>SEARCH FEE</u></th> <th><u>EXAMINATION FEE</u></th> </tr> </thead> <tbody> <tr> <td>Utility</td> <td>(\$300)</td> <td>(\$500)</td> </tr> <tr> <td>Design</td> <td>(\$200)</td> <td>(\$100)</td> </tr> <tr> <td>Reissue</td> <td>(\$300)</td> <td>(\$500)</td> </tr> <tr> <td>Provisional filing fee</td> <td></td> <td></td> </tr> </tbody> </table>			<u>FILING FEE</u>	<u>SEARCH FEE</u>	<u>EXAMINATION FEE</u>	Utility	(\$300)	(\$500)	Design	(\$200)	(\$100)	Reissue	(\$300)	(\$500)	Provisional filing fee			<p>(Total = \$1000) <input type="checkbox"/></p> <p>(Total = \$430) <input type="checkbox"/></p> <p>(Total = \$1400) <input type="checkbox"/></p> <p>(Total = \$200) <input type="checkbox"/></p>																
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<p>3. <u>APPLICATION SIZE FEE:</u></p> <p>Sheets of Spec and Drawings <input type="checkbox"/> (\$250 for each 50 sheets in excess of 100, except for sequence and program listings)</p>			<p>SUBTOTAL (2)+(3) (\$1100)</p>																															
<p>4. <u>EXTRA CLAIM FEES FOR UTILITY AND REISSUE:</u></p> <table> <thead> <tr> <th><u>Extra Claims</u></th> <th><u>Fee from Below</u></th> <th><u>Fee Paid</u></th> </tr> </thead> <tbody> <tr> <td>Total Claims <input type="checkbox"/> - 20** = <input type="checkbox"/> x <input type="checkbox"/> = <input type="checkbox"/></td> <td></td> <td></td> </tr> <tr> <td>Independent Claims <input type="checkbox"/> - 3** - <input type="checkbox"/> x <input type="checkbox"/> = <input type="checkbox"/></td> <td></td> <td></td> </tr> <tr> <td>Multiple Dependent claims: <input type="checkbox"/> - <input type="checkbox"/></td> <td></td> <td></td> </tr> </tbody> </table> <p>** or number previously paid, if greater; For Reissues, see below</p> <p><u>Fee Description</u></p> <p>Claims in excess of 20 (\$50 per claim)</p> <p>Independent claims in excess of 3 (\$200 per claim)</p> <p>Multiple dependent claim, if not paid (\$360)</p> <p>**Reissue: each independent claim over 3 and more than in the original patent (\$200 per claim)</p> <p>**Reissue claims: each claim over 20 and more than original patent (\$50 per claim)</p>			<u>Extra Claims</u>	<u>Fee from Below</u>	<u>Fee Paid</u>	Total Claims <input type="checkbox"/> - 20** = <input type="checkbox"/> x <input type="checkbox"/> = <input type="checkbox"/>			Independent Claims <input type="checkbox"/> - 3** - <input type="checkbox"/> x <input type="checkbox"/> = <input type="checkbox"/>			Multiple Dependent claims: <input type="checkbox"/> - <input type="checkbox"/>			<p>SUBTOTAL (4) (\$1100)</p>																			
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SUBMITTED BY			Complete (if applicable)	
Name (Print/Type)	Laura L. Whitmer	Registration No. (Attorney/Agent)	52,920	Telephone (513) 626-2721
Signature	<i>Laura L. Whitmer</i>		Date	April 12, 2006

+ This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. This will vary depending upon individual case. Any comments on the amount of time you are required to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P. O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

2103 Fxtrans.doc (Revised for P&G use 1/17/2006)

APR 12 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/902,048
 Inventor(s) : Michael Lee Vatter
 Filed : July 10, 2001
 Art Unit : 1617
 Examiner : Shengjun Wang
 Docket No. : 8163
 Confirmation No. : 7755
 Customer No. : 27752
 Title : Transfer-Resistant Makeup Removing Compositions

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450
 Dear Examiner,

This Appeal Brief is submitted in support of the Notice of Appeal transmitted to the PTO via facsimile on February 17, 2006, which set a two-month period for response.

REAL PARTY IN INTEREST

The real party of interest is The Procter & Gamble Company of Cincinnati, Ohio.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals, interferences, or judicial proceedings.

STATUS OF CLAIMS

Claims 1-6 and 8-12 stand rejected and are pending in the present application. Claim 7 has been cancelled. Claims 1-6 and 8-12 are appealed. A complete copy of the appealed claims is set forth in the Claims Appendix attached herein.

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STATUS OF AMENDMENTS

No amendment was filed.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a method for removing transfer resistant make-up compositions comprising the step of applying a safe and effective amount of a make-up removing composition comprising: from 0.1 to 30% of a crosslinked siloxane elastomer, preferably having a particle size of from above 10 to about 200 microns; from 10 to 80% of a solvent having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2}; and optionally, from about 0% to about 95% water. Preferably, the make-up contains at least about 10% by weight of a silicone gum and/or resin (specification page 2, lines 14-23). The present invention additionally relates to an insoluble substrate for application to the skin, such as in the form of a treated wipe (specification page 18, lines 25-27).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(I) Rejection under 35 USC §103(a).

ARGUMENTS

I. Claims 1-20 are patentable over Schulz in view of Dreschler in view of Fowler because there is no suggestion or motivation to modify or combine the references and the combined references do not teach or suggest all of the claim limitations.

Claims 1-6 and 8-12 have been rejected under 35 USC §103(a) as being unpatentable over Schulz et al, US 5,654,362 (hereinafter "Schulz") in view of Dreschler et al., US No. 6,071,503 (hereinafter "Dreschler") in further view of Fowler et al. US No. 5,534,265 (hereinafter "Fowler"). Appellants respectfully traverse this rejection for two reasons. First, there is no motivation to combine the references, as required in MPEP 2143.01. Second, the combined references do not teach or suggest all of the claim limitations, as required in MPEP 2143.03. Thus, the obviousness rejection given by the Examiner does not establish a *prima facie* case of obviousness. Therefore, Appellants

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contend that the claimed invention is unobvious and that the rejection should be withdrawn.

There is no motivation to combine Schulz with Dreschler. The Examiner states that it would have been obvious to one of ordinary skill in the art to employ the elastomer disclosed by Schulz for removing transfer resistant cosmetics. Appellants respectfully disagree. Schulz teaches siloxane gels made by reacting a \equiv Si-H containing polysiloxane with an alpha, omega-diene. Dreschler teaches a cosmetic composition applied to the lips comprising the combination of organosiloxane resins and fluid diorganosiloxane resins with a volatile carrier.

The Examiner states that one of ordinary skill in the art would have been motivated to incorporate further amounts of cyclodimethicone with the elastomer solid described in Schulz, if necessary for the removal of transfer resistant cosmetics. Appellants respectfully disagree. The Schulz reference is primarily directed to deodorant compositions. Column 2, lines 20-21 of Schulz states that the materials are ideal for use in solid cosmetics such as antiperspirants and deodorants. The Schulz reference only mentions the use of its silicone elastomer as a color cosmetic remover in a laundry list of potential uses. Most of the specification and the examples are directed to antiperspirant and deodorant compositions. One skilled in the art would not look to Schulz's teachings of solid antiperspirant and deodorant compositions to create a transfer resistant make-up removing composition.

One skilled in the art would have no motivation to combine Schulz's teachings of siloxane gels in an antiperspirant or deodorant composition with Dreschler's teaching of a cosmetic composition applied to the lips comprising organosiloxane resins and fluid diorganosiloxane resins. Therefore, Appellants contend that a *prima facie* case of obviousness has not been established, and the claimed invention is not obvious in view of the cited references.

In addition, the Examiner does not establish a *prima facie* case since the combined references fail to teach an element of the claimed invention. Specifically, Schulz, Dreschler, and Fowler do not teach or suggest a method for removing transfer resistant make-up compositions comprising the step of applying a safe and effective amount of a make-up removing composition comprising from about 0.1 to about 30% of a *non-*

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spherical crosslinked siloxane elastomer having a particle size of from about 10 to about 20 microns; from about 10 to about 80% of a solvent suitable for application to the skin having a *solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2}*; optionally, water; and an emulsifier, wherein the composition has a *viscosity greater than about 20,000 cps.* (emphasis added). None of the prior references teach or suggest a non-spherical crosslinked siloxane elastomer in combination with a solvent having a specific solubility parameter, wherein the composition has a specific viscosity.

The Examiner states that the optimal amounts of a cosmetic ingredient (i.e. the elastomer) or the viscosity of a cosmetic composition is considered within the skill of the artisan. Appellants respectfully disagree. Factors including the amount of elastomer present, the particle size of the elastomer, the amount of solvent present, the solubility parameter of the solvent, and the viscosity of the composition are all directly related to the composition's ability to act as a transfer resistant make-up removing composition. As stated above, Schulz is directly related to a solid deodorant or antiperspirant composition. Thus, one skilled in the art would not optimize a deodorant or antiperspirant composition in developing a transfer resistant make-up composition.

The Examiner also states that using non-spherical particles would have been obvious. Appellants respectfully disagree. As described on page 8, lines 10-18 of the specification, the non-spherical crosslinked siloxane elastomers of the present invention are thought to provide preferred rheology and film properties in order to achieve the benefits of the present invention. Specifically, when forming the gel matrix or network, non-spherical particles swell and/or pack more tightly than spherical particles. There is no hint in the prior references that signifies consideration that non-spherical crosslinked siloxane elastomers of the present invention provide such benefits.

None of the prior references teach or suggest a method for removing transfer resistant make-up compositions comprising the step of applying a composition comprising a non-spherical crosslinked siloxane elastomer of a specific particle size in the amount claimed in the present invention in combination with a solvent having a specific solubility parameter, wherein the composition has a specific viscosity. Therefore, Appellants contend that a *prima facie* case of obviousness has not been established, and the claimed invention is not obvious in view of the cited references.

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SUMMARY

In view of all of the above, it is respectfully submitted that the aforementioned rejection is erroneous. The Board's reversal of the rejection is respectfully requested.

Respectfully submitted,
THE PROCTER & GAMBLE COMPANY

Laura L. Whitmer
Signature

Laura L. Whitmer
Typed or printed name
Registration No. 52,920
(513) 626-2721

Date: April 12, 2006
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CLAIMS APPENDIX

1. (Rejected) A method for removing transfer resistant make-up compositions comprising the step of applying a safe and effective amount of a make-up removing composition comprising:
 - (i) from about 0.1 to about 30% of a non-spherical crosslinked siloxane elastomer said elastomer having a particle size of from above 10 to about 200 microns;
 - (ii) from about 10 to about 80% of a solvent suitable for topical application to the skin having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2};
 - (iii) optionally, from about 0% to about 90% water and;
 - (iv) an emulsifier;wherein the composition has a viscosity greater than about 20,000 cps.
2. (Rejected) The method of Claim 1 wherein the transfer resistant make-up is silicone gum or resin based.
3. (Rejected) The method of Claim 2 wherein the make-up removing composition further comprises a skin conditioning agent.
4. (Rejected) The method of Claim 1 wherein the skin conditioning agent is selected from the group consisting of humectants, exfoliants, emollients and mixtures thereof.
5. (Rejected) The method of Claim 4 wherein the skin conditioning agent is a humectant.
6. (Rejected) The method of Claim 5 wherein the humectant is selected from the group consisting of propylene glycol, dipropylene glycol, polypropylene glycol, polyethylene glycol, sorbitol, hydroxypropyl sorbitol, hexylene glycol, glycerin,

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1,3-butylene glycol, 1,2,6-hexanetriol, ethoxylated glycerin, propoxylated glycerin and mixtures thereof.

7. (Cancelled)
8. (Rejected) The method of Claim 1 wherein the emulsifier is polyoxyalkylene copolymer.
9. (Rejected) The method of Claim 8 wherein the polyoxyalkylene copolymer is dimethicone copolyol.
10. (Rejected) The method of Claim 1 wherein the crosslinked siloxane elastomer is a mixture of non-emulsifying and emulsifying crosslinked siloxane elastomers.
11. (Rejected) The method of Claim 1 wherein makeup removing compositions further comprises an active selected from the group consisting of peptides, palmitoyl-oligopeptide, farnesol, bisabolol, phytantriol, glycerol, urea, guanidine, ascorbic acid, vitamin A, vitamin E, vitamin B₃, vitamin B₅, sunscreens, anti-acne medicaments; antioxidants, flavonoids, skin soothing and healing agents, chelators, sequestrants, opacifiers and mixtures thereof.
12. (Rejected) A cosmetic removing wipe, comprising:
 - A. one or more layers of water-insoluble substrate; and
 - B. a safe and effective amount of a make-up removing composition comprising:
 - (i) from about 0.1 to about 30% of a non-spherical crosslinked siloxane elastomer said elastomer having a particle size of from above 10 to about 200 microns;
 - (ii) from about 10 to about 80% of a solvent suitable for topical application to the skin having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2};
 - (iii) optionally, from about 0% to about 90% water;

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(iv) an emulsifier;

wherein the composition has a viscosity greater than about 20,000 cps.